

REMARKS/ARGUMENTS

Claims 1-27 are pending in the present application. Claims 1-27 were canceled; no claims were amended; and claims 28-44 were added. The listing of the full version of claims beginning on page 2 of this response replaces all prior versions, and listings, of claims in the application.

Support for the new claims may be found in the original claims and in the specification and drawings as follows: page 7, line 21 to page 10, line 8 and Figures 3-9.

Further, with respect to all claim cancellations, amendments, and additions, Appellants are not conceding in this application that the subject matter of the claims prior to the cancellations, amendments, and additions is not patentable over the art cited by the Examiner. The present claim cancellations, amendments, and additions are made only for facilitating expeditious prosecution of the application. Appellants respectfully reserve the right to pursue these and other claims in one or more continuations and or divisional patent applications.

Reconsideration of the claims is respectfully requested.

I. Decision on Appeal of July 29, 2010

On July 29, 2010, the Board of Patent Appeals and Interferences issued a Decision in Appeal No. 2009-006595 for Application No. 10/626,194. In the Decision the Board vacated the grounds of rejection of the Examiner and issued a new ground of rejection. In response to the new ground of rejection, Appellants were required to either reopen prosecution by submitting an appropriate amendment of the claims so rejected or to request a rehearing. Appellants have elected to reopen prosecution by submitting an amendment of the claims.

II. New claims 28-44 are not obvious

The Examiner previously rejected claims 1-27 under 35 U.S.C. § 103 as being unpatentable over Matsliach et al., U.S. Patent Application No. 6879994 (hereinafter “*Matsliach*”) in view of Monza et al. (U.S. Publication No. 20040081183 A1) (hereinafter “*Monza*”). Final Office Action dated May 7, 2007, page 3. These rejections have been vacated by the Decision on Appeal in order to raise a new ground of rejection.

The Examiner bears the burden of establishing a *prima facie* case of obviousness based on prior art when rejecting claims under 35 U.S.C. § 103. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). The prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). In determining obviousness, the scope and content of the prior art are... determined; differences between the prior art and the claims at issue are... ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or non-obviousness of the subject matter is determined. *Graham v. John Deere Co.*, 383 U.S. 1 (1966). "Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue." *KSR Int'l. Co. v. Teleflex, Inc.*, No. 04-1350 (U.S. Apr. 30, 2007). "*Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.*" *Id.* (citing *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006))."

In rejecting the prior claims the Examiner stated the following in regard to monitoring usage data:

Monza et al. discloses a messaging system comprising a self learning component that keeps and monitors historical usage data and uses it to profile users of the system. This reads on the claimed "... wherein the statistical usage data is adapted to allow the end user to determine a best time to contact the target user for a messaging session by providing a plurality of data regarding the target user's ... the target user's messages sent and received." ("Part of PE component within engine 112 is a self-learning component. The self-learning component enables proactive Page 4 outbound contacts to be initiated using the most optimum media type and contact parameters to ensure the best chance for success of contact and probable response. For example, if a client like a business partner repeatedly does business with center 104 then all of his or her available media types, contact parameters, preferences, rules for etiquette, and normal itinerary, are stored in HDM within facility 114.

Final Office Action dated May 7, 2007, pages 3-9.

New claim 28 recites:

A method comprising:

detecting, by a processor, a plurality of messaging system events;
recording, by the processor, the plurality of messaging system events in a database;

compiling from the plurality of messaging system events, by the processor, a plurality of times for signing in and signing out of a target, an average time signed on each day of the target, and a plurality of messages sent and received by the target;

displaying, by the processor, the plurality of times for signing in and signing out of the target, the average time signed on each day of the target, and the plurality of messages sent and received by the target; and

determining from the plurality of times for signing in and signing out of the target, the average time signed on each day of the target, and the plurality of messages sent and received by the target, a best time to contact the target for a messaging session.

Claim 28 records, compiles and displays “a plurality of times for signing in and signing out of a target, an average time signed on each day of the target, and a plurality of messages sent and received by the target.” The combined art is silent in regard to the cooperation of the elements set forth in the claim and to the specific data displayed.

New claim 33 recites:

An apparatus comprising:

A computer having a processor connected to messaging system, a computer readable memory, and a computer readable tangible storage device;
first program instructions to detect a plurality of messaging system events of a target;

second program instructions to record the plurality of messaging system events in a database;

third program instruction to compile from the plurality of messaging system events a plurality of times for signing in and signing out of the target, an average time signed on each day of the target, and a plurality of messages sent and received by the target; and

fourth program instructions to display the plurality of times for signing in and signing out of the target, the average time signed on each day of the target, and the plurality of messages sent and received by the target;

wherein the first through the fourth program instructions are stored in the computer readable tangible storage device for execution by the processor via the computer readable memory.

New claim 33 records a plurality of messaging system events and then compiles and displays “a plurality of times for signing in and signing out of a target, an average time signed on each day of the target, and a plurality of messages sent and received by the target.” The combined art is silent in regard to the cooperation of the elements set forth in the claim and to the specific data displayed.

New claim 39 recites:

A computer program product comprising:
a computer readable storage device;
first program instructions detect a plurality of messaging system events of a target;
second program instructions to record the plurality of messaging system events in a database;
third program instruction to compile from the plurality of messaging system events a plurality of times for signing in and signing out of the target, an average time signed on each day of the target, and a plurality of messages sent and received by the target; and
fourth program instructions to display the plurality of times for signing in and signing out of the target, the average time signed on each day of the target, and the plurality of messages sent and received by the target;
wherein the first through the fourth program instructions are stored in the computer readable storage device.

New claim 39 records, compiles and displays “a plurality of times for signing in and signing out of a target, an average time signed on each day of the target, and a plurality of messages sent and received by the target.” The combined art is silent in regard to the cooperation of the elements set forth in the claim and to the specific data displayed.

III. Conclusion

It is respectfully urged that the subject application is patentable over the cited references and is now in condition for allowance.

The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

DATE: September 28, 2010

Respectfully submitted,

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